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Woodard, Emhardt, Moriarty, McNett & Henry LLP  
Bank One Center/Tower  
Suite 3700  
111 Monument Circle  
Indianapolis IN 46204-5137

12/12/08

*In re* Application of:

TRIEU, HAI H.

Serial No.: 10/717,684

Filed: Nov. 20, 2003

Docket: 4002-3269/PC775.00

Title: SYSTEMS AND TECHNIQUES FOR  
INTERBODY SPINAL STABILIZATION  
WITH EXPANDABLE DEVICES

DECISION ON PETITION

This is a decision on the petition filed on Nov. 10, 2008 in which the petitioner requests reconsideration and withdrawal of the restriction requirement issued on Jun. 21, 2006. This petition is considered as if pursuant to 37 CFR 1.144 and 37 CFR 1.181, and no fee is required.

The petition is **DISMISSED**.

The record shows that:

1. In the Jun. 21, 2006 Office action, a restriction requirement between two independent inventions and election of species and subspecies was made.
2. Ultimately on Feb. 12, 2007, the applicant filed a complete response and elected the system of FIG. 1 (to the extent material to method claims), a posterior approach and a device position exemplified in FIG. 3A. Claims 1, 2, 6-30, 33-34 read on the elected subject matter.
3. On May 11, 2007, a non-final Office action was issued. The examiner acknowledged the applicant's election with traverse and reiterated the propriety of the restriction requirement. Also, claims 1-2, 6-27, 29 and 33-34 were rejected and claims 3-5, 28, 38, 31, 32 and 35-71 were withdrawn from consideration.
4. On Aug. 13, 2007, the applicant filed a response to the non-final Office action cancelling a complete set of non-elected claims 35-71, adding dependent claims 72-73 and, inter alia, arguing propriety election of species requirement regarding remaining non-elected claims 3-5, 28, 38, 31, 32.
5. On Mar. 25, 2008, the examiner mailed another election of species requirement based on the claims as amended on Aug. 13, 2008. In particular, the examiner requested for clarification from the applicant regarding how the elected embodiment shown in at least figure 1 which is a tubular device (as shown in figure 2) can function as a motion preserving device.
6. On Apr. 25, 2008, page 10 of the response, the applicant elected species associated with methods including a motion preserving device, with traverse on at least the above grounds.

Claims 1-19, 21-34 and 72-73 read on that subject matter. The applicant believes claim 19 is generic claim because it does not specify either a motion preserving device or a non-motion-preserving device.

7. On Jul. 2, 2008, a final-Office action was mailed. The examiner maintained the rejection of elected claims 1, 2, 6-17, 19-27, 30, 33, 34 and 72-73 and withdrawn non-elected claims 3-5, 18, 28, 29, 31, 32 and 34 from consideration.
8. On Sep. 3, 2008, the applicant files a Rule 116 amendment with no amendment to the claims and included arguments to traverse the rejection.
9. On Oct. 8, 2008, the examiner mailed an Advisory Action informing the applicant that the amendment filed under Rule 116 has been entered.
10. On Nov. 10, 2008, the applicant filed the present petition for withdrawal of restriction requirement of the Mar. 28, 2008 Office action be reviewed and withdrawn.

### Discussion and Analysis

The Nov. 10, 2008 petition requested withdrawal of the restriction requirement imposed in the Mar. 25, 2008 Office action. The petitioner asserts that the restriction requirement was improper because the requirement did not focus on the subject matter of the claims, and so is not properly formulated. In particular, the petitioner indicated that there is insufficient evidence in the record to show independence and distinctness.

Pursuant to MPEP 803, there are two criteria for a proper restriction requirement: (1) the inventions must be independent or distinct as claimed and (2) there would be a serious burden on the examiner if restriction is not required.

In the Mar. 25, 2008 Office action, the examiner restricted the two species on the basis of being patentably distinct. In the Office action, the examiner identified that two species are 1) Method comprises placing a motion preserving to complete intervertebral distraction device and 2) Method comprises delivery of expandable device to restore and maintain a disc space height which is not a motion preserving device to complete intervertebral distraction. The species are mutually exclusive and are not obvious variants of each other based on the current record. The petitioner's arguments regarding the examiner's failure to focus on the claims because there was no set of figure grouped together to show all of the steps of claim 1. Therefore, the examiner's restriction requirement could not have been made based on the claims. This line of arguments is not is not persuasive. A review of this Office action shows the examiner has properly identified and grouped the species in accordance with MPEP 809.02(a) (B)<sup>1</sup>. In this case, the examiner has chosen to group the claims in accordance with the species to which they are restricted.

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<sup>1</sup> MPEP 809.02(B) Clearly identify each (or in aggravated cases at least exemplary ones) of the disclosed species, to which claims are >to be< restricted. The species are preferably identified as the species of figures 1, 2, and 3 or the species of examples I, II, and III, respectively. In the absence of distinct figures or examples to identify the several species, the mechanical means, the particular material, or other distinguishing characteristic of the species should be stated for each species identified. If the species cannot be conveniently identified, the claims may be grouped in accordance with the species to which they are restricted. >Provide reasons why the species are independent or distinct.

In addition, there must be a patentable difference between the species as claimed as required by MPEP 806.04(h)<sup>2</sup>. A review of the record shows that the applicant has not clearly admitted on the record that the species are not patentably distinct or identify any evidence showing the species to be obvious variants (see the last paragraph of page 3 of the Office action of Mar. 25, 2008). Since the claims directed to the Species 1 and 2 are patentable over each other, then, the election of species requirement of Mar. 25, 2008 is proper.

Furthermore, the examiner must establish there is a serious burden on the examiner if restriction is not required, pursuant to MPEP 808.02. In particular, MPEP 808.02(C)<sup>3</sup> states that a serious burden exists where it is necessary for the examiner to search different fields for the restricted species. The last paragraph of page 2 of the Mar. 25, 2008 Office action, the examiner noted that the species do require different fields of search. In particular, the serious search burden arises from the mutually exclusive characteristics of Species 1 and 2. Each species does require a different field of search in different classes/subclasses or electronic resources and/or using different search queries. It should be noted that the application of prior art references to one species would not likely be applicable to another species.

In the petition, the petitioner also requested that the Director acknowledge that the features claimed in other non-elected claims can be rejoined on allowance of a generic claim. This has been stated in the examiner Office action of Mar. 25, 2008 (first paragraph of page 4). In particular, the applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

### Conclusion

For the reasons outlined above, the restriction requirement imposed in the Mar. 25, 2008 Office action and made final in the Jul. 2, 2008 Office action is in accordance with proper Office procedure. Accordingly, the election of species requirement of Mar. 25, 2008 is proper.

The application is being forwarded to the examiner via his Supervisory Patent Examiner for further processing. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181". Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner, at (571) 272-4856.

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<sup>2</sup> MPEP 806.04(h)Species Must Be Patentably Distinct From Each Other[R-3] \*\*In making a requirement for restriction in an application claiming plural species, the examiner should group together species considered clearly unpatentable over each other \*\*.

<sup>3</sup> MPEP 808.02 Establishing Burden [R-5] (C)A different field of search: Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes/subclasses or electronic resources, or employing different search queries, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

Accordingly, the petition is **DISMISSED**.



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Donald T. Hajec, Director  
Technology Center 3700